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AMENDMENT

IN THE CLAIMS:

Claims 40 and 41 are currently amended to correct typing mistakes. In addition a number of the claims were previously amended to correct typing mistakes. Any claims amended to correct typing mistakes were not intended to surrender any equivalents whatsoever under the to the Doctrine of Equivalents. All pending Claim 1-41 are included herein.

1. (Previously Twice Amended) A method of accessing a computer file having information content and invoking an application for manipulating the information content of the accessed computer file, comprising the steps of:

creating an icon corresponding to a computer file having information content, the icon substantially depicting at least a portion of the information content from the computer file;

linking the icon to an application that is separate from the computer file and adapted to manipulate the information content of the computer file;

storing the icon in memory;

displaying the icon;

invoking the application for manipulating the information content of the computer file upon selection of the icon and opening the computer file within the application.

2. (Previously Twice Amended) The method of claim 1, wherein the step of creating an icon corresponding to a computer file having information content,

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the icon substantially depicting at least a portion of the information content of the computer file comprises creating an icon substantially depicting a display of the information content from the computer file while the computer file is being manipulated by the application.

3. (Previously Twice Amended) The method of claim 1, wherein the step of creating an icon corresponding to a computer file having information content, the icon substantially depicting at least a portion of the information content from the computer file includes capturing a graphical representation of the computer file while the application is manipulating the computer file.

4. (Previously Amended) The method of claim 3, wherein capturing a graphical representation is initiated by a user input command while the application manipulating the computer file is active.

5. (Original) The method of claim 4, wherein the user input command is a keyboard command.

6. (Previously Amended) The method of claim 1, further comprising the step of storing information related to the application for manipulating the computer file in a memory along with the icon.

7. (Original) The method of claim 1, further comprising the step of displaying the icon in a window on a screen display.

8. (Original) The method of claim 7, further comprising the step of displaying the window when a cursor is positioned at an edge of the screen display.

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9. (Original) The method of claim 8, further comprising the step of concealing the window when the cursor is positioned outside the window.

10. (Previously Amended) The method of claim 1, wherein the step of invoking the application for manipulating the information content of the computer file upon selection of the icon and opening the computer file within the application consists of invoking the application and opening the computer file upon a single user input command selecting the icon.

11. (Original) The method of claim 10, wherein the single user input command comprises depressing a button when a cursor is placed over the icon.

12. (Original) The method of claim 11, wherein the button is a mouse button and the cursor is a mouse-driver cursor.

13. (Previously Amended) The method of claim 1, wherein if an application is active then the step of invoking the application for manipulating the information of the computer file upon selection of the icon and opening the computer file within the application comprises accessing the active application.

14. (Previously Amended) The method of claim 1, further comprising the step of storing data related to the computer file and the corresponding application each time the computer file and application is opened and closed during a session, and wherein the step of invoking the application for manipulating the information content of the computer file upon selection of the icon and opening the computer file within the application comprises invoking the computer file and

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the application based on the stored data related to computer file and corresponding application.

15. (Previously Amended) The method of claim 14, wherein the data related to the computer file and the corresponding application includes a document path, a document handle, and application path, and an application handle.

16. (Previously Amended) The method of claim 1, wherein the step of invoking the computer file and the corresponding application for manipulating the information of the computer file upon selection of the icon and opening the computer file within the application further includes printing the computer file.

17. (Previously Amended) The method of claim 1, wherein the step of invoking the application for manipulating the information content of the computer file upon selection of the icon and opening the computer file within the application comprises copying the computer file to designated storage device.

18. (Previously Twice Amended) The method of claim 1, wherein the step of creating an icon corresponding to a computer file having information content, the icon substantially depicting at least a portion of the information content from the computer file comprises creating an icon corresponding to a template file.

19. (Previously Twice Amended) A method for providing a user interface for accessing a file based on a corresponding icon comprising:

storing a plurality of icons in a memory along with a corresponding plurality of references to an underlying file system for storage information for a

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plurality of files, each icon having an appearance substantially depicting
information content from its corresponding file;

linking an application to each icon based utility on the ability of the
application to manipulate the information content of the file corresponding to the
icon;

providing a window on a display screen for displaying the plurality of icons;

invoking the application for manipulating the information content of the file
corresponding to the selected icon upon selection of an icon from the plurality of
icons in the window;

accessing the file designated by the reference to the underlying file
system corresponding to the selected icon; and

opening the accessed file into the corresponding application.

20. (Previously Amended) The method of claim 19, wherein the step of
storing a plurality of icons in a memory further comprises storing data related to
an application for manipulating the corresponding file along with each of the
plurality of icons and wherein the step of invoking the application corresponding
to the selected icon comprises invoking an application based on the
corresponding stored data related to the application.

21. (Original) The method of claim 20, further comprising providing a user
interface for accepting a user input command to initiate storing an icon in a
memory along with a corresponding reference to the underlying file system for
storage information for the file.

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22. (Original) The method of claim 21, wherein the user input command is a keyboard command.

23. (Original) The method of claim 19, wherein one of the plurality of icons substantially depicts a display of the corresponding file while the file is being manipulated by the application.

24. (Original) The method of claim 19, wherein the step of providing a window for displaying the plurality of icons comprises providing a plurality of windows.

25. (Original) The method of claim 19, wherein the step of invoking the application further includes printing the file.

26. (Original) The method of claim 19, wherein the step of invoking the application comprises copying the file to a designated storage device.

27. (Previously Twice Amended) A method of using icons to switch between a plurality of files having information content and corresponding applications for manipulating the content of the files on a computer having a file system and an operating system user interface to the files within the file system, the icons being references to the files separate from the operating system user interface to the files within the file system, the method comprising:

creating and storing an icon for each of the plurality of files along with data relating an application for manipulating the information content of the file to the file associated with the icon and data referencing a storage location of the file within the file system;

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selecting an icon from the window;
invoking the file and the application for manipulating the information content of the file corresponding to the selected icon based on the data related to the application and the data referencing the storage location of the file; and
opening the file within the application.

28. (Previously Amended) The method of claim 27, wherein the icon substantially depicts information content from the file.

29. (Original) The method of claim 27, further comprising the steps of providing a window for displaying the icons and displaying the window based on a user-initiated display action.

30. (Original) The method of claim 29, wherein the step of displaying the window comprises displaying the window based on movement of a cursor to a predefined screen location.

31. (Original) The method of claim 30, wherein movement of a cursor to a predefined screen location comprises movement of a cursor to an edge of a screen.

32. (Original) The method of claim 30, further comprising concealing the window based on movement of the cursor to a second predefined screen location.

33. (Original) The method of claim 27, wherein the step of selecting an icon from the window comprises placing a cursor over the icon and depressing a button.

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34. (Original) The method of claim 33, wherein placing a cursor over an icon and depressing a button comprises placing a mouse-driven cursor over an icon and depressing a mouse button.

35. (Original) The method of claim 27, wherein if an application is active then the step of invoking the file and the application for manipulating the file comprises accessing the active application.

36. (Original) The method of claim 27, wherein the step of invoking the file and the application for manipulating the file further includes printing the file.

37. (Original) The method of claim 27, wherein the step of invoking the file and the application for manipulating the file comprises copying the file to a designated storage device.

38. (Original) The method of claim 27, wherein the applications include at least two of a word processor, a database program, a spreadsheet program, and a drawing program.

39. (Currently Amended and Previously Twice Amended) A method for providing a template file for access outside an application comprising:

storing a file to be manipulated by an application as a template file along with an icon corresponding to the template file and data relating the application used to manipulate the information content of the template file to the file for the icon;

marking the template file as read-only;

displaying the icon outside the application;

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invoking the template file and the application used to manipulate the
information content of the template file when the icon is selected;

opening the template file within the application.

40. (Currently Amended and Previously Amended) The method of claim
39, wherein the icon substantially depicts information content from the template
file.

41. (Currently Amended) The method of claim 40, wherein the icon
substantially depicts a display of the template file while the template file is being
manipulated by an the application.

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RESPONSE

SECTION 102(e) REJECTIONS

The Examiner rejected Claims 1-41 under 35 U.S.C. 102(e) as being anticipated by Barber et al. (hereinafter Barber), U.S. Patent No. 5,751,286.

SECTION 102(e) RESPONSE

The Applicant traverses all of the Examiner's assertions for all claims 1-41 and responds as follows.

CLAIM 1:

The Examiner is reminded that *a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1997). Barber clearly does not describe each and every element of Applicant's Claim 1, either expressly or inherently and therefore cannot anticipate Applicant's Claim 1 for the following reasons.

The first element of Claim 1 recites: "creating an icon corresponding to a computer file having information content, the icon substantially depicting at least a portion of the information content from the computer file."

In addition, Claim 1 as twice previously amended includes a second element: "linking the icon to an application that is separate from the computer file and adapted to manipulate the information content of the computer file."

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The Examiner asserts "regarding claim 1, Barber et al. discloses a method of accessing a computer file 10 and application for manipulating the file 31, creating an icon corresponding to a file including information (see col 5, lines 1-51); the icon 89 substantially depicting at least a portion of the information from the file (see col 8, lines 59-62 and col 1-25); storing the icon in a memory; displaying the icon; and invoking the file and an application for manipulating the file upon selection of the icon (See col 6, lines 30-60)."

The Examiner is reminded that "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382,1385 (CCPA 1970).

The Examiner immediately violates the holding of *In re Wilson* by asserting an anticipation rejection and yet at the same time ignoring words of the first element and the second element altogether of Claim 1. Since the Examiner made no comment on the underlined words in element one of Claim 1 and did not consider element 2 of claim 1 at all, Barber clearly cannot anticipate Applicant's Claim 1 since each and every element of Applicant's Claim 1 is not described by Barber in violation of the holding of *Verdegall Bros. v. Union Oil Co. of California*.

The Examiner therefore has not made a *prima facie* case of anticipation under 102(e) based on his assertions and the Applicant need not respond any further. However, for completeness, the Applicant responds to the Examiner's other assertions to further illustrate why Barber cannot anticipate Claim 1.

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First, the Examiner asserts Barber "discloses a method of accessing a computer file 10 and application for manipulating the file 31, creating an icon corresponding to the file including information (see col. 5, lines 1-51)."

There are several problems with this assertion by the Examiner. First, item 10 in Barber is not a computer file as the Examiner asserts but instead is a data processing system 10 (Col. 4, line 58). Second, item 31 in Barber is not an application for manipulating the file 10 or data processing system 10 as asserted by the Examiner. Instead, item 31 as taught by Barber is an image database management system (Col. 5, line 26) that runs under the data processing system 10 (FIG. 1) and not the other way around as the Examiner asserts. The Examiner appears to be confused as to how the invention taught by Barber actually works.

Since the Examiner, by his confused assertions, indicates that Barber doesn't expressly teach element one of claim 1, the Examiner appears to be stating that Barber inherently describes the first element of the Applicant's claim. However, the Examiner is reminded that the fact that a certain result of characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result of characteristic. *In re Rijckaert*, 9 F.3d 1351, 1354 (Fed. Cir. 1993). In addition, in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the

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teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

To comply with the holdings of *In re Rijckaert* and *Ex parte Levy*, the Applicant requests the Examiner provide a basis in fact and/or technical reasoning to reasonably support the Examiner's assertions that the computer file taught by Applicant is the equivalent of the data processing system 10 taught by Barber and the application taught by the Applicant is the equivalent of the database management system 31 taught by Barber.

Based on the Examiner's assertions about elements 10 and 31 of Barber and the Examiner's confusion attached thereto, the Applicant submits that the Examiner has not provided any such reasonable basis in fact and/or technical reasoning in violations of the holdings of *In re Rijckaert* and *Ex parte Levy*.

In addition, Barber at Col. 5, lines 1-51 also does not describe the first element of the Applicant's claim 1 as the Examiner asserts. Instead Barber at Col. 5, lines 1-51 describes, in general, an image query system in which a query is constructed that is used to search plural existing images in a database management system.

The Applicant requests the Examiner specifically indicate where in lines 1-51 of Col. 5 that the Examiner finds language relating to creating an icon corresponding to a computer file including information content, the icon substantially depicting at least a portion of the information content from the file.

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Barber uses the word "create" at Col. 7, line 18 where Barber teaches the deposit of a thumbnail creates an object 70. This object 70 is not an icon or even a whole image, but instead is data representing only the spire portion of image 40 (See FIG. 4 and Col. 7, lines 34-36). Thus, Barber does not teach creating an icon at Col. 5 lines 1-51 or Col. 7 line 18.

The Examiner further asserts that Barber teaches "the icon 89 substantially depicting at least a portion of information from the file (see col. 8, lines 59-62 and col 1-25)."

However, Barber at Col. 8, lines 59-62 again teaches details of the image query process and not creating an icon at all. Barber teaches icon 89 is a pre-existing image query system icon. At Col. 9, lines 1-4 Barber teaches icon 89 is an image query icon 89 on which a user may click to begin an image query. Alternatively, a query object may be dragged to the image query icon 89 or an appropriate command may be typed into a command line (not shown). At Col. 11, lines 49-51 Barber teaches a query-by-image content procedure is initiated in step 211 by, for example, selecting the query button 89 in the example image window 90, which issues a RUN QUERY command.

Thus, Barber does not teach icon 89 is created as part of the steps of the method of the invention and does not substantially depict at least a portion of information from a file as the Examiner asserts as this Icon 89 is a pre-existing component of the image query system.

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In addition, there appears to be a typing mistake after the and including "col 1-25". The Barber patent includes only 20 columns and not 25 columns. If the Examiner is asserting that the whole Barber patent teaches this portion of the element one of claim 1, then the Examiner is reminded that the particular part of a reference relied on must be designated. See 37 C.F.R. §1.104(c)(2).

Claim 1 further recites additional elements for storing the icon in memory; displaying the icon; invoking the application for manipulating the information content of the computer file upon selection of the icon and opening the computer file within the application.

The Examiner further asserts that Barber teaches "storing the icon in a memory; displaying the icon; and invoking the file and an application for manipulating the file upon the selection of the icon (see col 6, lines 30-60)."

However, at Col. 6, lines 30-60, Barber instead in general instead teaches details about thumbnail image data definitions.

Thus, Barber does not teach, either expressly or inherently each and every element as set forth in Claim 1 as the Examiner asserts. Therefore, Barber cannot anticipate Claim 1 based on the holding of *Verdegall Bros. v. Union Oil Co. of California*.

The Examiner is also reminded that to anticipate a claim, the identical invention must be shown in as complete detail as is contained in the Applicant's claims. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

The Examiner is also reminded to anticipate a claim, the claim elements must be

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arranged as required by the applicants claim. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

Barber doesn't teach the applicant's invention at any level of detail. Barber teaches an image query system and method (Title) and images in an image database are searched in response to queries (Abstract). In contrast, the Applicant teaches a system and method for iconic software environment management (Title) and for storing, navigating and accessing files within an operating system through the use of a graphical thumbnail representing a video display of an active document with an active application (Abstract). The Examiner is urged to compare the detailed description and remaining claims of Barber to the Applicant's application.

Barber's claim elements are not the same as the Applicant's. Claim 1 of Barber teaches claim elements including displaying windows and receiving image queries. Claim 1 of the Applicant's application, described above, teaches in part creating an icon corresponding to a file including information content, the icon substantially depicting at least a portion of the information content from the file.

Thus, Barber cannot anticipate the Applicant's application based on the holdings of *Richardson v. Suzuki Motor Co.* and *In re Bond* either. Therefore the 102(e) rejection is improper based on these holdings and should be immediately withdrawn.

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Based on all of the arguments above, Barber does not teach either expressly or inherently each and every element as set forth in Claim 1 of the Applicant's application. Thus, Barber does not anticipate Claim 1 of the Applicant's application. Therefore the 102(e) for Claim 1 is improper and should be immediately withdrawn.

CLAIMS 2-41:

The arguments for independent Claim 1 above are incorporated by reference for the other Independent claims and dependent Claims 2-41. Claims 2-41 include additional limitations not recited by Claim 1. The Examiner is reminded that if an independent claim is not anticipated, than any claim depending there from is also not anticipated. Since Claim 1 is not anticipated by Barber, claims 2-41 cannot be anticipated by Barber. Thus, the 102(e) rejections for these claims are also improper and should be immediately be withdrawn.